

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

V. Douglas
#18/Response
2-7-03

In re application of: Masini

Serial No.: 09/523,503

Group No.: 3732

Filed: March 10, 2000

Examiner: E. Robert

For: OPTIMIZING PATELLAR FEMORAL MECHANICS THROUGH ALTERNATIVE DEPTH REFERENCING

RESPONSE TO OFFICE ACTION

RECEIVED

JAN 31 2003

TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed September 19, 2002, the Examiner's attention is directed to the following remarks.

The claims of this application are being resubmitted in unamended form so that this matter may be taken up on appeal to the Board.

With regard to claim 12 containing "non-statutory subject matter," human body parts **ARE NOT BEING POSITIVELY RECITED**. On occasion non-statutory subject matter must be *referred to* in the body of a claim, or else the claim might not be intelligible or enabling. It is Applicant's understanding, from conversing with senior examiners in medical technology groups, that the use of "a" as opposed to "the" overcomes this problem.

With regard to the specification not providing "clear support" for the claimed terminology, the Applicant's comment that "movable member," "movable guide," "reference guide," and so forth do not appear in the specification is incorrect. The Examiner should be aware that the claims of an application *as originally filed* constitute disclosure, just like the rest of the specification.

With regard to the rejection under 35 U.S.C. §112, second paragraph, the Examiner appears to

Serial No. 09/523,503

- 2 -

32001sh

be misguided here as well. It seems to be the Examiner's argument that an apparatus claim cannot have any functional language whatsoever. But again, sometimes functional language is required to make a claim understandable and meaningful, which is why claims can be drafted in means-plus-function language. See 35 U.S.C. §112, sixth paragraph.

With regard to the rejections under 35 U.S.C. §102(b), Applicant relies on all of the arguments previously made of record.

Respectfully submitted,

By: _____

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh, Sprinkle,

Anderson & Citkowski, PC

280 N. Old Woodward Ave., Ste 400

Birmingham, MI 48009

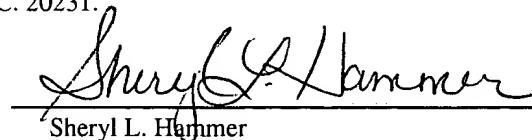
(734) 913-9300 FAX (734) 913-6007

Date: Jan. 21, 2003

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: January 21, 2003



Sheryl L. Hammer